

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Toshiharu Furukawa et al. Confirmation No.: 6993
Art Unit: 1756
Serial No.: 10/798,908
Examiner: Stephen D. Rosasco
Filed: March 11, 2004
Atty. Docket No.: ROC9200300389US1
For: METHODS OF FORMING ALTERNATING PHASE SHIFT MASKS
HAVING IMPROVED PHASE-SHIFT TOLERANCE

Cincinnati, Ohio 45202

Date: January 15, 2007

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response is responsive to the non-final Office Action mailed December 20, 2006. Claims 1-48 are pending. Applicants appreciate the Examiner's indication that claims 37-48 are allowed. In view of the following remarks, Applicants respectfully submit that all claims in this application are in complete condition for allowance and request reconsideration of the application in this regard.

Rejections of Claims

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Pub. No. 2005/0158634 to Thony et al. (hereinafter *Thony*) in view of U.S. Pat. No. 6,048,625 to Nguyen et al. (hereinafter *Nguyen*) or U.S. Pub. No. 2002/0195673 to Chou et al. (hereinafter *Chou*) and further in view of U.S. Pat. No. 5,460,908 to Reinberg (hereinafter *Reinberg*).

Thony is a national phase application of PCT No. PCT/FR03/01400, which was published in French by WIPO as International Publication No. WO03/096121. According to MPEP § 706.02(f) and Example 5 in MPEP § 706.02(f), *Thony* has no 102(e) prior art date because the WIPO publication is not in English.

Thony claims foreign priority to French Application No. 02/05718, which was published by the National Institute of Industrial Property (L'INPI) as French Publication No. 2839560. According to MPEP §§ 706.02(f), 715(III)(A) and Example 3 in MPEP § 706.02(f), the prior art date accorded to *Thony* under 35 U.S.C. 102(e) is the earliest effective U.S. filing date (i.e., November 5, 2004). No benefit of the filing date of French Application No. 02/05718 is given under 35 U.S.C. § 102(e) for prior art purposes as to *Thony*.

The U.S. filing date of *Thony* is November 5, 2004, which represents the earliest effective prior art date under 35 U.S.C. § 102(e) for *Thony*. This effective prior art date is after the filing date of the present application. Accordingly, *Thony* is not prior art to the present application. On this basis, Applicants respectfully request that the Examiner withdraw the rejection.

Applicants recognize that French Publication No. 2839560 and International Publication No. WO03/096121 are available as publications under 35 U.S.C. 102(a). Specifically, International Publication No. WO03/096121 published on November 20, 2003 and French Publication No. 2839560 published on November 14, 2003. Each of these publication dates is less than one year before the filing date of the present application.

Applicants submit an affidavit of prior invention under 37 C.F.R. § 1.131, as an attachment herewith, which has been executed by all inventors of the subject matter claimed. The affidavit establishes that Applicants invented the claimed subject matter before the publication dates of French Publication No. 2839560 and International Publication No. WO03/096121. Attached to the affidavit is a photocopy of an original exhibit consisting of a written invention disclosure and annotated drawings. Applicants' showing of facts is, in character and weight, sufficient as to establish that the inventors conceived a semiconductor structure that embodies the features and advantages of the present invention, as claimed in the

present application, in the United States prior to November 14, 2004, which represents the earliest publication date from among French Publication No. 2839560 and International Publication No. WO03/096121. Consequently, French Publication No. 2839560 and International Publication No. WO03/096121 are not valid references under 35 U.S.C. § 102(a).

Conclusion

Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In view of the foregoing remarks, this application is submitted to be in complete condition for allowance and, accordingly, a timely notice of allowance to this effect is earnestly solicited. In the event that any issues remain outstanding, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicants do not believe fees are dues in connection with filing this communication. If, however, any fees are necessary as a result of this communication, the Commissioner is hereby authorized to charge any under-payment or fees associated with this communication or credit any over-payment to Deposit Account No. 23-3000.

Respectfully submitted,

January 15, 2007
Date

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